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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221511
Party	Plaintiff NIKE, Inc.
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		)	
NIKE, INC.,		)	
	Opposer,	)	Opposition No. 91221511
vs.		)	Application No. 86330661
		)	
CAPITAL E FINANCE CO, LLC,		)	MARK: JUST DID IT
	Applicant.	)	
		)	

Opposer, NIKE, INC. (“Opposer” or “NIKE” ), and Applicant, CAPITAL E FINANCE CO., LLC (“Applicant” or “CEF”), in accordance with their Accelerated Case Resolution (“ACR”) Stipulation approved by Trademark Trial & Appeal Board (“TTAB” or “Board”) in its order dated October 1, 2015, hereby stipulate that the following facts are not in dispute in this proceeding:

2. NIKE has standing to bring this proceeding based on its prior pleaded trademark Registration Nos. 1,875,307, 4,350,316 and 4,704,671, and pending Application No. 86/444,421 (which is now Reg. No. 4,764,071) for its trademark JUST DO IT (“NIKE’s Mark” or “JUST DO IT”) as detailed below:

<b>Mark</b>	<b>Application No./Filing Date/Registration No./Registration Date</b>	<b>Goods/Class/Dates of First Use</b>
JUST DO IT.	App. No. 73/829,171 Filed 10/3/89 Reg. No. 1,875,307 Reg. Date: 1/24/95	Goods: Clothing, namely T-shirts, Sweatshirts and Caps Int. Class 25 First Use: 1/26/89 First Use Commerce: 1/26/89
JUST DO IT	App. No. 85/795,981 Filed 12/6/12 Reg. No. 4,350,316 Reg. Date: 6/11/13	Goods: Eyeglass frames; Sunglasses Int. Class 9 First Use: 10/31/08 First Use Commerce: 10/31/08
JUST DO IT	App. No. 86/048,407 Filed 8/26/13 Reg. No. 4,704,671 Reg. Date: 3/17/2015	Goods: Cell phone cases; Parts and accessories for cell phones, namely, cell phone covers; Specialty carrying cases for cell phones; Cases for hand-held computing devices; Protective covers for hand-held computing devices; Eyewear; Sunglasses Int. Class 9 First Use: 10/31/08 First Use Commerce: 10/31/08
JUST DO IT	App. No. 86/444,421 Filed: 11/4/2014 Reg. No. 4,764,071 Reg. Date: 06/30/2015	Goods: All purpose sport bags; Backpacks. Int. Cl. 18 First Use: 07/01/2011 First Use Commerce: 07/01/2011  Good: Footwear; Headbands; Headwear; Pants; Shorts; Sports bras; Tank tops; Tights; Warm up suits Int. Cl. 25 First Use: 1/26/89 First Use Commerce: 1/26/89

3. NIKE's Registration Nos. 1,875,307, 4,350,316 and 4,704,671 all have application filing dates prior to July 8, 2014.

4. NIKE's Registration No. 1,875,307 is incontestable.

5. NIKE also owns other trademark registrations for JUST DO IT, including Registration Nos. 1,817,919 and 1,931,937.

6. NIKE began using the trademark JUST DO IT in connection with the goods cited in its pleaded registrations prior to the filing date of CEF's application on July 8, 2014.

7. NIKE has used the trademark JUST DO IT in commerce continuously since January 26, 1989.

8. NIKE's trademark JUST DO IT is famous.

9. NIKE's trademark JUST DO IT became famous before CEF filed its application for JUST DID IT on July 8, 2014.

10. In 2011, in its precedential decision in *Nike v. Maher*, 100 USPQ2d 1018 (TTAB 2011), the TTAB held that NIKE's trademark JUST DO IT is famous both for likelihood of confusion and dilution purposes. "...we have found opposer's mark famous for dilution purposes...In view of the foregoing, we find that opposer's mark is famous for likelihood of confusion purposes." *Id.* at 1021.

11. In *Nike v. Maher*, 100 USPQ2d 1018 (TTAB 2011), the TTAB held that the trademark JUST JESU IT for clothing was likely to cause confusion with and to dilute NIKE's famous trademark JUST DO IT and sustained NIKE's opposition. Specifically, on the issue of likelihood of confusion, the TTAB stated that:

Opposer's famous mark, JUST DO IT, is entitled to a wide scope of protection. *See, e.g., Bose Corp. v. QSC Audio Prod.'s Inc.*, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) ("Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.") The goods involved are identical in part and are presumed to travel through the same trade channels and be purchased by the same classes of consumers. The marks are similar in their entireties, giving due weight to their appearances, sound, meaning and commercial impressions. In view of the foregoing, we find that applicants' mark JUST JESU IT is likely to cause confusion with Opposer's mark JUST DO IT. *Id.* at 1024.

On the issue of dilution, the TTAB stated that:

Accordingly, we find that applicants' mark is likely to dilute Opposer's mark under Trademark Act § 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). Opposer has shown on this record that its mark is famous, that it became famous prior to the filing date of Applicants' application for their mark, and that an association exists between the parties' marks that would impair the distinctiveness of Opposer's famous mark. *Id.* at 1031-1032.

12. Since the issuance in 2011 of the *Nike v. Maher* decision discussed above, NIKE has continued to use and extensively advertise its JUST DO IT Mark.

13. Prior to *Nike v. Maher*, the following four trademarks had been issued by the USPTO either without opposition or over an opposer's objections:

- a. Just Brew It; April 3, 2001; registration #2439760;
- b. Just Be It; October 15, 2002; registration #2634997;
- c. Just Grab It; October 23, 2007; registration #3317983; and
- d. Just Jew It; December 4, 2007; registration #3349372.

14. From the *Nike vs. Maher* decision:

Applicants, however, have introduced certified status and title copies of four active (and one cancelled) registrations for "JUST ... IT" marks, which have been registered for clothing, arguing that inasmuch as the U.S. Patent and Trademark Office has permitted these registrations to co-exist, there can be

no valid basis for denying applicants a registration. We disagree.

Third-party registrations have little probative value by themselves because they tell us nothing about whether or not the marks are actually being used or the manner of any such use. *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1614 (TTAB 2010); *see also Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983). Applicants have not submitted evidence or testimony to prove that the third-party marks are in use. Without evidence as to how, or whether, the third-party marks have been used, we cannot assess whether any such use has been so widespread as to have had an impact on consumer perceptions.

To the extent the registrations have been offered not to establish use but to indicate that the phrase is a commonly registered expression having a suggestive meaning, we have considered the registrations for this purpose. In this regard, the existence of the four active registrations does not persuade us that the phrase “just ... it” would be considered a commonly registered element such that a mark following this pattern but with a different middle term would thereby be rendered, as a whole, distinguishable from opposer's famous mark. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub'd*, No. 92-1086 (Fed. Cir. June 5, 1992).

This dilution factor favors opposer. *Id.* at 1028.

15. Opposer has successfully opposed or petitioned to cancel the following trademark applications and registrations of marks including the phrase “JUST ...IT”, (with their proceeding number and termination dates):

MARK	PROCEEDING NUMBER	TERMINATION DATE
JUST JUICE IT	Opposition Number: 91090678	October 26, 1993
JUST DO IT LIKE YOU MEAN IT!	Opposition Number: 91159496	October 1, 2004
JUST DIG IT	Opposition Number: 91159865	November 27, 2004

<b>MARK</b>	<b>PROCEEDING NUMBER</b>	<b>TERMINATION DATE</b>
NOOKIE...JUST DID IT!	Opposition Number: 91163474	April 28, 2005
JUST DOUGH IT	Opposition Number: 91163646	June 18, 2005
JUST KIK-N-IT	Cancellation Number: 92044860	April 5, 2006
JUST SPIN IT	Opposition Number: 91166679	January 20, 2006
JUST DUNE IT	Opposition Number: 91167295	November 3, 2006
JUST STICK IT	Opposition Number: 91169712	July 5, 2006
JUST NAIL IT	Opposition Number: 91169848	November 30, 2006
JUST NON-DO IT	Opposition Number: 91174667	May 18, 2007
DO JUST IT	Opposition Number: 91179431	May 8, 2008
JUST DRINK IT	Opposition Number: 91180569	February 7, 2011
JUST TUBE IT	Opposition Number: 91182260	May 19, 2008
JUST STICK IT	Opposition Number: 91184010	October 2, 2008
JUST HANDLE IT	Opposition Number: 91184207	September 12, 2008
JUST ADD IT	Opposition Number: 91184206	September 11, 2008
JUST O2 IT	Opposition Number: 91185448	November 17, 2008
JUST FLOP IT	Opposition Number: 91187730	March 19, 2009
JUST TASTE IT	Opposition Number: 91188970	June 4, 2009
1 JUST DO ONE and JUST DO ONE	Opposition Number: 91193381	May 11, 2010
JUST JESU IT	Opposition Number: 91188789	October 24, 2011
JUST BUY IT	Opposition Number: 91196082	November 4, 2010

<b>MARK</b>	<b>PROCEEDING NUMBER</b>	<b>TERMINATION DATE</b>
JUST KITE IT	Opposition Number: 91196301	February 28, 2011
JUST THROW IT	Opposition Number: 91196463	January 4, 2011
JUST WEAR IT	Opposition Number: 91200408	March 6, 2012
JUST SHAVE IT	Opposition Number: 91202503	March 13, 2012
DON'T JUST DO IT DO IT RIGHT	Opposition Number: 91208950	May 28, 2015
JUST FAKE IT	Opposition Number: 91217251	August 21, 2014
DON'T JUST DO IT...DO IT RIGHT. VV & V	Cancellation Number: 92059548	March 9, 2015
JUST MAK'IN IT	Opposition Number: 91217899	August, 29 2014
JUST FIX IT!	Opposition Number: 91218955	January 28, 2015
JUST CHEW IT	Opposition Number: 91219095	January 15, 2015
FRAC-N-HOSE JUST FRAC IT	Opposition Number 91219572	March 27, 2015

16. CEF is a company primarily engaged in the business of financing or arranging financing for energy and environmental related projects and businesses.

17. CEF filed its Application No. 86/330,661 for JUST DID IT pursuant to Section 1(b) of the Trademark Act on July 8, 2014, asserting its bona fide intention to use the mark JUST DID IT in commerce in connection with all of the goods identified in its Application No. 86/330,661.

18. The goods identified in CEF's Application No. 86/330,661 are: Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic

apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Button down shirts; Button-front aloha shirts; Clothing for athletic use, namely, padded shirts; Collared shirts; Golf shirts; Graphic T-shirts; Hooded sweat shirts; Knit shirts; Long-sleeved shirts; Maternity clothing, namely, shirts; Night shirts; Open-necked shirts; Polo shirts; Rugby shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleeves worn separate and apart from blouses, shirts and other tops; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sun protective clothing, namely, shirts; Sweat shirts; T-shirts; Tee shirts; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Turtle neck shirts; Wearable garments and clothing, namely, shirts; Yoga shirts in International Class 25.

19. CEF does not claim rights to JUST DID IT as a trademark in connection with any of the goods set forth in its application prior to the filing date of its application on July 8, 2014.

20. CEF did not use JUST DID IT as a trademark in connection with any of the goods set forth in its application prior to the filing date of its application on July 8, 2014.

21. Since filing its Application No. 86/330,661, CEF has not made use, or use in commerce, of its mark JUST DID IT as a trademark in connection with the goods set forth in its application.

22. NIKE has never given CEF any consent or permission or otherwise authorized CEF to use or register the mark JUST DID IT in connection with any goods or services, nor has CEF requested the same.

23. There is no connection or affiliation between NIKE and CEF or CEF's goods or services.

Respectfully submitted,

Stipulated On December 23, 2015 by NIKE, INC., through its Attorneys	Stipulated On January 4, 2016 by CAPITAL E FINANCE CO., LLC through its Manager and Authorized Representative
<p>/helen hill minsker/ _____ (signature)</p> <p>Helen Hill Minsker Maurine Knutsson BANNER &amp; WITCOFF, LTD. 10 South Wacker Drive, Suite 3000 Chicago, Illinois 60606 (t) 312-463-5000 Email: <a href="mailto:hminsker@bannerwitcoff.com">hminsker@bannerwitcoff.com</a>, <a href="mailto:mknutsson@bannerwitcoff.com">mknutsson@bannerwitcoff.com</a>, <a href="mailto:bwptotm@bannerwitcoff.com">bwptotm@bannerwitcoff.com</a>, <a href="mailto:bwlitdocket@bannerwitcoff.com">bwlitdocket@bannerwitcoff.com</a></p>	<p>/Matthew Heller/ (signature)</p> <p>Matthew Heller Capital E Finance Co, LLC 53 APPLETON ST BOSTON, MA 02116-6213 (t) 617-365-0990 <a href="mailto:capitalefinance@gmail.com">capitalefinance@gmail.com</a></p>

### CERTIFICATE OF SERVICE

I hereby certify that a copy of this Parties' Stipulation of Facts Not in Dispute Pursuant to the Accelerated Case Resolution (ACR) Stipulation was served by first class mail to the following address on January 4, 2016, such being the Applicant's correspondence address listed in the TTABVUE system as of this date:

Matthew Heller  
Capital E Finance Co, LLC  
53 Appleton Street  
Boston, Massachusetts 02116-6213  
United States

A courtesy copy of the foregoing document is also being sent this same day to Applicant's representative, Matthew Heller, at the following email address: capitalefinance@gmail.com .

/helen hill minsker/

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Helen Hill Minsker